

REMARKS

Claims 1 and 3-13 were pending in the application at the time of the Office Action. By this response applicant has not cancelled, amended, or added any claims. All of the pending claims are rejected in the Office Action solely under the judicially created doctrine of obviousness-type double patenting in view of claims 1-55 of U.S. Patent No. 7,397,977. Applicant respectfully traverses this rejection. Of the rejected claims, claims 1, 4, 6, and 7 are independent claims.

At the outset, Applicant notes that "... the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination." *MPEP* § 804.II.B.1. Moreover, the Court of Appeals for the Federal Circuit has held, in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678, 683 (Fed. Cir. 1986) for example, that obviousness-type double patenting rejections must include clear evidence to establish why an alleged variation of an invention claimed in a prior patent would have been obvious. The Manual for Patent Examining Procedure ("MPEP") is in accord. See, e.g., *Id.* ("Any obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue ... would be an obvious variation of the invention defined in a claim in the patent."). Applicant notes that the MPEP also makes it clear that "the focus of any double patenting analysis necessarily is on the claims in the multiple patents or patent applications involved in the analysis." *MPEP* § 804, *emphasis added*.

With the foregoing in view, it does not appear that the Examiner has performed the requisite analysis. For example, regarding claim 1, the Office Action has not identified what is

purported to constitute the allegedly obvious combination or modification of claims 1-55 of the '977 Patent. Nor has the Office Action asserted, or established, the existence of a motivation to make such a modification. Additionally, the Office Action has not established that claims 1-55 of the '977 Patent teach or suggest all the elements of claims 1, 4, 6, and 7.

Instead, the Office Action has simply asserted that:

“although the conflicting claims are not identical, they are not patentably distinct from each other because a wave propagation medium for converting an optical path of a leakage light that is not emitted from a predetermined output port of the circuit element so as to prevent the leakage light from being coupled to a different circuit element as claimed in this application can be obviously done by the device claimed in U.S. patent number 7397977.”

That is, the Office Action has asserted, without any discussion or analysis, that claims 1-55 of the '977 Patent disclose a portion of only one of the independent claims (claim 1), and simply states that this element “can be obviously done” by the device claimed in the '977 patent. Applicant respectfully submits that this vague assertion does not rise to the level of “clear evidence” that is required by Federal Circuit precedent, and by the examination guidelines.

Furthermore, the Office Action does not even assert that claims 1-55 of the '977 Patent disclose any of the other elements of the rejected claims, nor that it would have been obvious to modify claims 1-55 to include those elements.

In addition, applicant submits that the '977 patent fails to disclose or even suggest any sort of leakage light, let alone a wave propagation medium “for converting an optical path of a leakage light that is not emitted from a predetermined output port of the circuit element so as to prevent the leakage light from being coupled to a different circuit element,” as recited in independent claim 1. Applicant notes that as set forth in the application of the present invention, because of this element, the variation in the insertion loss of the optical circuit decreases and the crosstalk of the MZ-type optical combining/splitting circuit decreases (See paragraph 0049). As

a result, Applicant submits that, contrary to the assertion of the Office Action, it would not have been obvious to have modified the '977 patent to come up with the currently claimed inventions.

For at least the foregoing reasons, Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 1, 4, 6, and 7. Accordingly, applicant respectfully requests that the obviousness-type double patenting rejection of claims 1, 4, 6, and 7 be withdrawn and the claims be allowed.

Claims 3, 5, and 8-13 variously depend from independent claims 1, 4, 6, and 7. As such, claims 3, 5, and 8-13 incorporate the elements thereof. Inasmuch as the obviousness-type double patenting rejection of claims 3, 5, and 8-13 also rely on the characterization of claims 1-55 of the '977 Patent, Applicant submits that the rejections of claims 3, 5, and 8-13 are deficient for at least the same reasons given above. Accordingly, Applicant respectfully requests that the obviousness-type double patenting rejection of claims 3, 5, and 8-13 also be withdrawn and the claims be allowed.

No other objections or rejections are set forth in the Office Action.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 1 and 3-13 as presented herein.

The Commissioner is hereby authorised to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to deposit account number 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and re-examination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to deposit account number 23-3178.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 14th day of April 2009.

Respectfully submitted,

/Scott A. Woodbury/ Reg. #55743
SCOTT A. WOODBURY
Registration 55,743

DANA L. TANGREN
Registration No. 37,246

Attorneys for Applicant
Customer No. 022913
Telephone No. 801.533.9800

SAW:cad
2260681_1